



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/711,000

11/09/2000

Mark A. Hollar

200

6001

31665

7590

07/21/2004

PATENT DEPARTMENT
MACROVISION CORPORATION
2830 DE LA CRUZ BLVD.
SANTA CLARA, CA 95050

EXAMINER

ELISCA, PIERRE E

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/711,000

Applicant(s)

HOLLAR, MARK A.

Examiner

Pierre E. Elisca

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is in response to Applicant's Response, filed on 4/26/2004.
2. Claims 1-73 are pending.
3. The rejection to claims 1-73 under 35 U.S.C. 102 (e) as being anticipated by Wonfor et al. (U.S. Pat. No. 6,381,747) and 35 U.S.C. 102 (e) as being anticipated by Sims, III (U.S. Pat No. 6,438,235) as set forth in the Office action mailed on 09/09/2003 is maintained.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371[©] of this title before the invention thereof by the applicant for patent.

5. **Claims 1-73 are rejected under 35 U.S.C. 102 (e) as being anticipated by Wonfor et al. (U.S. pat. No. 6,381,747).**

As per claims 1, 15, 17-21, 30-35, 38-42, 46, 48-51, 57, 59-63, and 69-73 Wonfor discloses a method/system of providing copy protection of video analog and digital signals and the like, comprising:

Art Unit: 3621

ascertaining terms for providing a protected material to a prospective recipient according at least in part to information of unauthorized copying of other protected material previously provided to said prospective recipient (see., abstract, col 4, lines 21-67, specifically wherein it is stated that the right holders authorize video service providers to apply copy protection to the program material); and providing or withholding a copy of said protected material to said prospective recipient in accordance with said terms (see., abstract, col 5, lines 30-67, col 8, lines 18-45, col 7, lines 53-67, col 8, lines 1-8).

As per claims 2, and 22 Wonfor discloses the claimed method wherein said ascertaining further includes obtaining said information of unauthorized copying from a database (see., abstract, col 5, lines 7-65).

As per claims 3, 4, 5, 23, 24, 25, 45, 56, and 64 Wonfor discloses the claimed method wherein said providing comprises providing a copy of said protected material to said prospective recipient in the form of a file (see., abstract, fig 2, digital video, col 5, lines 30-47).

As per claims 6-14, 16, 26-29, 36, 37, 42-44, 47, 52-55, 58, and 65-68, Wonfor discloses the claimed method of embedding an identification of said protected material in said copy prior to providing said copy to said prospective recipient (see., col 7, lines

Art Unit: 3621

53-67, col 8, lines 1-8, please note that embedding identification is readable as a password or watermark).

6. Claims 1-73 are rejected under 35 U.S.C. 102 (e) as being anticipated by Sims, III (U.S. pat. No. 6,438,235).

As per claim 1, 15, 17-21, 30-35, 38-42, 46, 48-51, 57, 59-63, and 69-73 Sims discloses a method/system for providing copy protection of content stored on a bulk storage media, comprising:

ascertaining terms for providing a protected material to a prospective recipient according at least in part to information of unauthorized copying of other protected material previously provided to said prospective recipient (see., abstract, col 2, lines 21-67, specifically wherein it is stated that under the terms of a license agreement); and providing or withholding a copy of said protected material to said prospective recipient in accordance with said terms (see., abstract, col 2, lines 21-67, col 3, lines 7-45, col 7, lines 53-67, col 8, lines 1-8).

As per claims 2, and 22 Sims discloses the claimed method wherein said ascertaining further includes obtaining said information of unauthorized copying from a database (see., abstract, col 2, lines 44-62).

Art Unit: 3621

As per claims 3, 4, 5, 23, 24, 25, 45, 56, and 64 Sims discloses the claimed method wherein said providing comprises providing a copy of said protected material to said prospective recipient in the form of a file (see., abstract, col 3, lines 35-47).

As per claims 6-14, 16, 26-29, 36, 37, 42-44, 47, 52-55, 58, and 65-68, Sims discloses the claimed method of embedding an identification of said protected material in said copy prior to providing said copy to said prospective recipient (see., col 1, lines 64-67, col 2, lines 1-13, col 4, lines 25-64, col 8, lines 1-8, please note that embedding identification is readable as a password or watermark or key).

RESPONSE TO ARGUMENTS

7. Applicant's arguments filed on 4/26/2004 have been fully considered but they are not persuasive.

REMARKS

8. In response to Applicant's arguments, Applicant argues that the prior art of record (Wonfor and Sims III) fail to disclose:

a. "ascertaining terms for providing material to a prospective recipient according at least in part to information of unauthorized copying of other protected material previously provided to said prospective recipient". As noted in the Office action mailed on 09/09/2003, Wonfor discloses this limitation in the abstract, col 4, lines 21-67, specifically wherein said the right holders authorize video service providers to apply

Art Unit: 3621

copy protection to the program material. Also, see., Sims III, col 2, lines 21-67, wherein said under the terms of a license agreement.

b. " providing or withholding a copy of said protected material to said prospective recipient in accordance with said terms". Based upon the rejection mailed on 09/09/2003, it is believed that Wonfor discloses this limitation in the abstract, col 5, lines 30-67, col 7, lines 53-67, col 8, lines 18-45, col 8, lines 1-8. see., Sims II, col 2, lines 21-67, col 3, lines 7-45, col 8, lines 1-8.

c. " obtaining said information of unauthorized copying from a database". However, the Examiner respectfully disagrees because Wonfor discloses this limitation in col 5, lines 7-65, specifically wherein said obtain a taped copy 26 without authorization, the unauthorized copy will be degraded to the degree that it is un-watchable.

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 3621

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Pierre Eddy Elisca

Primary Patent Examiner

July 15, 2004